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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/920,611 08/27/97 BERRY

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EXAMINER

HM42/0626

ROBERT A. FRANKS
SCHERING-PLough CORPORATION
PATENT DEPARTMENT, K-6-1, 1990
2000 GALLOPING HILL ROAD
KENILWORTH NJ 07033-0530

BAWA, R

ART UNIT

PAPER NUMBER

2

1615

DATE MAILED:

06/26/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on _____

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-16 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-16 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been
 received.
 received in Application No. (Series Code/Serial Number) _____
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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Detailed Action

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (C.C.P.A. 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (C.C.P.A. 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (C.C.P.A. 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected under the judicially created doctrine of double patenting over claims of U. S. Patent No. 5,474,759 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

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Both set of claims disclose essentially similar drug aerosols. Oleic acid ~~on as~~ the surfactant (col. 3, line 43) and alcohols (col. 3, line 36) are disclosed by USP 5,474,759.

The cited art is analogous because it pertains to the field of the inventor's endeavor and is also reasonably pertinent to the particular problem with which the inventor is involved. *In re Wood*, 202 U.S.P.Q. 171, 174. Note that a comprising-type language does not exclude other steps, elements or materials. *Cues Inc. vs. Polymers Industries*, U.S.P.Q. 2d 1847 (DC ND GA 1988). Moreover, (i) it is well established that the claims are given the broadest interpretation during examination; (ii) references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 U.S.P.Q. 545 (C.C.P.A. 1969). No criticality of the concentrations of the ingredients has been established. No comparative data over the closest prior art demonstrating any unexpected results and/or improvements has been established. The claimed MDI and method are well known in the art and inherent to the disclosure of USP 5,474,759.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during

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prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (C.C.P.A. 1968). See also MPEP § 804.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Raj Bawa, Ph.D., whose telephone number is (703) 308-2423. The examiner can normally be reached on Tuesday through Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

BAWA, Ph.D.; aco


RAJ BAWA, Ph.D.
PRIMARY EXAMINER
GROUP 1600

June 25, 1998